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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,625	01/23/2002	Brian J. Marquardt	10-01	4966

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GREENLEE WINNER AND SULLIVAN P C  
5370 MANHATTAN CIRCLE  
SUITE 201  
BOULDER, CO 80303

EXAMINER

STAFIRA, MICHAEL PATRICK

ART UNIT PAPER NUMBER

2877

DATE MAILED: 04/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/055,625

Applicant(s)

MARQUARDT ET AL.

Examiner

Michael P. Stafira

Art Unit

2877

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 10-43 is/are allowed.
- 6) ☐ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 27 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2,8,9 are rejected under 35 U.S.C. 102(b) as being anticipated by Amirkhanian et al. ('261).

#### **Claim 1**

Amirkhanian et al. ('261) discloses a cylindrical probe tip having a cylinder having first and second openings at first and second ends of the cylinder (See Fig. 7); a spherical lens (Fig. 7, Ref. 266) disposed inside the probe tip cylinder and secured at the first opening (See Fig. 7), a seal (Fig. 7, Ref. 246) between the cylinder and the spherical lens at the first opening (See Fig. 7).

#### **Claim 2**

The reference of Amirkhanian et al. ('261) further discloses the seal is an adhesive (See Fig. 5).

#### **Claim 8**

Amirkhanian et al. ('261) further discloses an instrument (Fig. 5, Ref. 118) interface at the second opening of the second end of the cylinder (See Fig. 7).

### **Claim 9**

The reference of Amirkhanian et al. ('261) further discloses the interior surface at the first opening of the cylinder probe is round (See Fig. 7).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amirkhanian et al. ('261).

### **Claims 3-7**

Ref A discloses the claimed invention except for the seal is braise, cylinder is composed of metals, plastics, etc..., the lens is composed of glass, doped glass, etc.... It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine Amirkhanian et al. ('261) with the different materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

### ***Allowable Subject Matter***

5. Claims 10-43 are allowed over the prior art of record.

6. The following is a statement of reasons for the indication of allowable subject matter:


Regarding claims 10, 26 the prior art fails to disclose or make obvious an optical immersion probe having a first gasket seated inside the probe tip at the first opening such that the opening of the gasket is aligned with the first opening of the probe tip and a second gasket seated inside the probe tip on top of and in contact with the spherical lens, and in combination with the other recited limitations of claims 10, 26. Claims 11-25, 27-36 are allowed by the virtue of dependency on the allowed claim 10.

Regarding claim 37, the prior art fails to disclose or make obvious an optical immersion probe having a first o-ring seated inside the probe tip at the first opening such that the opening of the gasket is aligned with the first opening of the probe tip, and a second o-ring seated inside of the probe tip on top of the spherical lens, and in combination with the other recited limitations of claim 37. Claims 38-43 are allowed by the virtue of dependency on the allowed claim 37.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Stafira whose telephone number is 703-308-4837. The examiner can normally be reached on 4/10.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank Font can be reached on 703-308-4881. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7721 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



Michael P. Stafira  
Primary Examiner  
Art Unit 2877

April 17, 2003